REMARKS

Reconsideration and allowance of the claims in the application are requested.

Applicant's attorney thanks Supervisory Patent Examiner N. Maung and Examiner T. Nguyen for the courtesy of a personal interview conducted June 23, 2005. The interview discussed independent claims 1-4, 41, 42 and 61 with respect to the cited art. The Examiners agreed that the limitation "permitting a user of the first portable terminal to initiate a coupon matching sequence in the first portable terminal that compares the stored coupon information with wireless transmissions of promotions in effect at a retail outlet when entered and if a match occurs granting discounts on goods and services or other benefits to the user;" was not disclosed suggested or taught in the cited references alone or in combination. The limitation "wirelessly transferring at least part of the stored coupon information corresponding to granted discounts on goods and services resulting from said coupon matching sequence including the coupon ID number from the first portable terminal to a second portable terminal to effect wider distribution of the coupon information so as to permit users of each of said first and second portable terminals to redeem said coupon information during different transactions" was also discussed and the Examiners indicated the limitation was not present in the cited references, alone or in combination. Claims 59 and 60 were discussed. The Examiner will review the specification for support of the claims. An update search will be conducted and Applicant's attorney advised of any new art. This Interview Summary supplements the Examiner's Interview Summary dated June 23, 2005.

Now turning to the Office Action, Claims 1-4, 6, 8, 10, 11, 13, 15,.17, 19-21, 24, 26, 28, 29, 31, 33, 35, 37-39, 41, 42, 50, 59-60 are in the application.

Claims 5, 7, 9, 12, 14, 16, 18, 22, 23, 25, 27, 30, 32, 34, 36, 40 and 43-58 have been withdrawn from consideration.

Claims 1, 3, 6, 8, 10, 11, 13, 15, 17, 19-21, 24, 26, 28, 29, 31, 33, 35, 37-39 have been rejected.

Claims 2, 4, 41, 42, 59 and 60 have been objected to as failing to comply with the written description requirement.

Claims 1-4, 8, 11, 13, 17, 19-20, 26, 29, 31, 35, 37-38 and 41-42 have been rejected under 35 USC 103(a) as being unpatentable by USP 6,385,591 to Mankoff, issued May 7, 2002,

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filed May 11, 1999 (Mankoff), in view of Granger et al., U.S. Publication No. 2002/0007306, published January 17, 2002 (Granger) and in further view of USP 5,665,953 to Mazzamuto et al., issued September 9, 1997, filed February 14, 1996 (Mazzamuto).

Claims 6, 10, 15, 21, 24, 28, 33 and 39 have been rejected under 35 USC 103(a) as being unpatentable by Mankoff in view of Granger et al. and of Mazzamuto and in further view of USP 6,327,300 to Souissi et al., issued December 4, 2001, filed October 25, 1999 (Souissi).

Claim 42 has been rejected under 35 USC 103(a) as being as unpatentable by Mankoff, in view of Granger et al., and in view of Mazzamuto, and in further view of USP 6,311,171 to P. W. Dent, issued October 30, 2001, filed July 11, 1997 (Dent)

Claim 61 has been added to the pending claims. Claim 61 combines claim 1 and claim 19 to describe transferring the coupon information to another terminal via a wireless link and the Internet. Claim 19 has been canceled.

Applicant responds to the indicated Paragraphs of the rejection, as follows:

Regarding Paragraph 1:

Applicant responds to the Examiner's Response to Amendment, as follows:

A.   Applicant's Argument, First Paragraph, Page 17:

Claims 3 and 4 recite "…..storing the coupon (ID) information in said memory, a visual representation of the coupon information being stored in a remote server for subsequent downloading to another terminal, when needed,…" The limitation is supported in the specification at page 4, lines 1-6 and clearly describes or at least suggest to a worker skilled in the art that "coupon IDs are used in lieu of coupon images" to save storage space in the portable terminal.

B.   Applicants' Argument, Second Paragraph, page 17:

Mankoff at col. 5, lines 40-45 discloses "One technique for authenticating the coupon (or the user, as the case may be) is to have the redemption site send a message to a server that issued the coupon or that manages such validity checks." In contrast, applicant at page 8, lines 12-16 discloses "In Step 150, the point-of-sale terminal validates the electronically transmitted coupon and electronically redeems it by providing an immediate discount to the customer in accordance with the requirements of the coupon." It is clear Mankoff validates the coupon at a server remote

from the point-of sale terminal whereas Rissanen validates and redeems the coupon at the point-of sale terminal.

C.   Applicant's Argument, Fourth Paragraph, Page 17:

The Palm Device of Mankoff; the receiver of Granger and the scanner of Mazzamuto, alone or in combination, are all inoperative with respect to "a coupon matching sequence in the first portable terminal that compares the stored coupon information with wireless transmissions in effect at a retail outlet..."

Summarizing, Mankoff modified by Granger and Mazzamuto does not disclose, suggest or teach a worker skilled in the art to:

(1) push coupon ID information in lieu of coupons from a network server to a portable terminal anywhere in a network (Mankoff accesses a server via a portable terminal (PDA) to download actual or virtual coupons, not coupon ID information; Granger directly scans coupon information, not coupon ID information into a data collector; Mazzamuto receives coupon information, not coupon ID information only within a defined range of a retail outlet, not regardless of location in a network);

(2) wirelessly transfer promotions from a terminal at a retail outlet for matching in the portable terminal when the retail outlet is entered; (Mankoff transfers the coupons in the portable terminal to a terminal for matching and redemption; Mazzamuto matches scanned coupons to stored coupons for retrieval by a terminal at a retail outlet; Granger distributes promotions from a retail outlet to a portable terminal for subsequent redemption at the retail outlet, and

(3) wirelessly transfer the matched promotions from the portable terminal to a terminal for validation and redemption (Mankoff wirelessly transfers unmatched coupons to a terminal for redemption after off-site validation; Mazzamuto retrieves matched promotions from a data collector at a retail register for redemption; Granger delivers the coupon to retail outlet for redemption).

(4) wirelessly transfer at least part of the stored coupon information from the first portable terminal to a second portable terminal to permit users of the first and second portable terminals to redeem the coupon information. Mankoff, Granger and Mazzamuto all fail to disclose transferring coupon information between portable terminals for wider distribution of the coupon information.

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D.   Claim 3 Argument at Page 19:

Mankoff at col. 2, lines 7-17 discloses a web site downloading virtual coupons to a portable terminal whereas Rissanen discloses downloading a visual image stored in a portable terminal to another terminal which may be a portable terminal, as descried in Rissanen at page 15, lines 19-27.

E.   Claim Objections:

1.   Claims 2, 4, 41-42 fail to comply with the written description requirement. The claim(s) contains subject matter "different transactions".

While it is not stated in the description that the first and second portable terminals enter into different transaction with a redemption terminal, it would be apparent to any one skilled in the art that such transactions are different since they involve different portable terminals. Further the Manual of Patent Examination Procedure (MPEP) at Section 2163, page 172 states "What is conventional or well known to one of ordinary skill in the art need not be disclosed in detail .See Hybritech Inc.v Monalclonal Antibodies, Inc. 802 F 2d at 1384, 231 USPQ at 94. If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of the filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g. Vas-Cath, 935 F 2dat 156319 USPQ2dat 1116; Martin v Johnson, 454 F 2d 746, 751, 172 USPQ 391, 395 (CCPA 1972)."

Moreover, it is inherent in the written description that the first and second portable terminals enter into different transaction. MPEP 2163.07(a), at page 184 states " to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and it would be so recognized by persons of ordinary skill in the art..."

2.   Claims 59 and 60 are objected to as failing to comply with the written description requirement. The claims(s) contain subject matter "sharing coupon information".

The description at page 7, lines 19 – 27 describes a wireless terminal forwarding an electronically transmitted coupon to another wireless terminal for the wider distribution of the electronically transmitted coupon. In effect, the portable terminals "share the coupon information", as recited in claims 59 and 60. Again, on the authority of MPEP Section 2163 and

2167 (a) cited above, it would be apparent to a worker skilled in the art and inherent in the description that the inventor had possession of the invention by coupon information being shared by first and second terminals for wider distribution of the electronically transmitted coupon.

Summarizing, Applicant submits the description, the original claims and the MPEP citations make clear that a worker skilled in the art would have understood the claimed invention as enhancing the purchase of coupon related products, and the inventor had possession of the invention via (a) first and second portable terminals sharing coupons, and (b) entering into different transactions. Withdrawal of the objections and allowance of claims 2, 4, 41-42, and 59-60 are requested

Regarding Paragraphs 2 and 3:

Claims 1-4, 8, 11, 13, 17, 19-20, 26, 29, 31, 35, 37-38 and 41-42 include limitations not disclosed or suggested in Mankoff, of record, in view of Granger, of record, and further in view of Mazamutto, of record, as follows:

a. Claims 1 and 41:

(i) "wireless transferring by pushing coupon information including a coupon identification (ID) number to a first portable terminal, via a network regardless of location in the network"

Mankoff, at col. 2, lines 3-5, discloses "a user of a PDA having a wireless Internet connection may navigate to a website and select a link (e.g., a link in an advertising banner) and receive the virtual coupon directly." It is well understood that pushing coupon information means a website automatically sends the information without downloading. Moreover, there is no disclosure in Mankoff that the downloaded coupon, actual or virtual, includes a coupon ID or number, as described in Rissanen at page 4, lines 1-4. Mankoff fails to disclose pushing coupons including a coupon number strings as a coupon ID information.

Mankoff, at col. 5, lines 38-40, discloses "a given identifier (e.g., a coupon serial number) with a given user (or user identifier, such as a cookie). In contrast, Rissanen discloses coupon identifier (ID) or a number string that is associated with the coupon and not with the user. Mankoff fails to disclose coupon IDs or number strings in place of coupon images.

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(ii)   "storing the coupon (ID) information therein... said coupon information entitled the carrier of the carrier of coupon information to a discount on a purchase of goods and/or services."

Mankoff, at col. 4, lines 18-36, discloses, "the user later synchronizes his or her PDA device to the client (PC), the virtual coupon is automatically downloaded to the PDA. Preferably, the virtual coupon is stored in the memo or notepad section of the PDA..." In contrast, Rissanen receives coupon IDs or number strings with are not the same as or equivalent to the virtual coupons downloaded to the PDA. Further, Rissanen receives and stores the coupon ID information without requiring any action by the portable terminal. Accordingly, Mankoff fails to disclose sending coupon ID information automatically without requiring action by the portable terminal and storing coupon ID information, which are not the same as or equivalent to a virtual coupon described in Mankoff.

(iii)   "displaying a representation of a transferred coupon information on a first portable terminal;"

Mankoff, at col. 1, lines 44-45, discloses an electronic or virtual coupon is obtained when a user selects a given link in a web page being displayed on a client machine". Mankoff discloses a coupon image that is displayed on a client or PC synchronized to a PDA. Mankoff does not appear to have any disclosure directly displaying the coupon on the PDA serving as the portable terminal. In contrast, Rissanen directly displays the coupon ID information on a portable terminal, as described in the specification at page 7, lines 13-18 and shown in Fig. 2. Mankoff fails to disclose directly displaying coupon information on a display contained in the mobile terminal.

(iv)   "wirelessly transferring at least part of the stored coupon information corresponding to granted discounts on goods and services, resulting from said coupon matching sequence including the coupon ID number from the first portable terminal to another terminal for redemption during a transaction. "

Mankoff, at col. 5, lines 37-38, discloses a coupon number assigned to the user for fraud prevention purposes and not for redemption purposes. Mankoff directly downloads or transfers the coupon to a redemption terminal, via an electronic communication link; whereas, Rissanen downloads or electronically transfer the coupon ID information, after a coupon matching

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sequence. The Examiner has acknowledged in an Interview dated June 30, 2004, that Mankoff fails to disclose "wirelessly transferring at least part of a stored coupon information corresponding to granted discounts and goods and services resulting from said coupon matching sequence, including the coupon ID number for a first portable terminal to another terminal for redemption".

(v)   "validating in the another terminal the transferred coupon information if the coupon information corresponds to any of the goods and/or services involved in the transaction;"

Mankoff, at col. 5, lines 40-46, discloses, "one technique for authenticating the coupon (or user, as the case may be) is to have the redemption site send a message to a server that issued the coupon or that manages such validity checks." Mankoff discloses validating the coupon at an off-site terminal; whereas, Rissanen discloses validating the coupon ID information at the redemption terminal and calculating the discount, provided by the coupon information for purchases of goods and/or services. Mankoff fails to disclose validating the coupon ID information at the redemption terminal.

The Examiner acknowledges the limitation, "wirelessly pushing coupon information" is not show or suggested in Mankoff. Modifying Mankoff with Granger at Paragraph 0008 would download promotion information when a portable terminal was within proximity to a business establishment with which the promotion information is associated. In contrast, Rissanen discloses downloading promotion information, regardless of the location of the portable terminal in the network. Granger does not supply the missing limitations in Mankoff relating to downloading coupon information to a portable terminal regardless of terminal location in a network.

The Examiner acknowledges the limitation, "a coupon matching sequence in the first portable terminal that compares a stored coupon information with wireless transmission or promotions is not disclosed in Mankoff. Modifying Mankoff with Mazzamuto at col. 2, lines 39-54 would scan product code information from a coupon into a data collector for matching a product coupon list stored in the data collector Mazzamuto manually scans promotions into a data collector for matching to stored product codes, whereas, Rissanen wirelessly receives promotions for matching with stored coupons when entering a retail outlet. Mazzamuto fails to disclose the missing limitation in Mankoff.

Mankoff, Granger and Mazzamuto, alone or in combination, fail to disclose, suggest or teach (a) pushing coupon ID information to a portable terminal, via a network, regardless of the location in the network and without requiring action by the portable terminal; (b) storing and matching the coupon information within the portable terminal with wireless transmissions of promotions in effect at a retail outlet, when entered; (c) wirelessly transferring the stored coupon information resulting from a coupon matching sequence to another terminal for validation and redemption. The rejection of claims 1 and 41 under 35 USC 103(a) is without support in the cited art. Withdrawal of the rejection and allowance of claims 1 and 41 are requested.

B.   Claim 2:

(i)   "wirelessly transporting at least part of the stored coupon information... from the first portable terminal to a second portable terminal to effect wider distribution of the coupon information..."

Claim 2 depends from claim 1 and includes the further limitations relating to transferring stored coupon information from a first portable terminals to a second portable terminal to effect wider distribution of the coupon information. The Examiner has failed to provide prior art disclosing the transfer of coupon information from the first portable to a second portable terminal to affect wider distribution in the coupon information. In the absence of cited art there is no basis for the rejection of claim 2 under 35 USC 103(a). In any case claim 2 is distinguishable from Mankoff, Granger and Mazzamuto for the same reasons indicated in connection with the consideration of claim 1. Withdrawal of the rejection and allowance of claim 2 are requested.

C.   Claim 3:

(i)   "storing the coupon ID number in said memory thereof, a visual representation of the coupon information being stored in a remote server for subsequent downloading to another terminal when needed..."

Mankoff, at col. 5, lines 6-20, discloses coupons are stored either at the PDA or at a server. In contrast, Rissanen discloses coupon ID information is stored in the portable terminal and visual coupon representations are stored at a server. The visual coupons are downloaded by the portable terminal, when needed. Mankoff fails to disclose storing coupon ID information at the portable terminal and downloading visual coupon representation from a server, as needed.

(ii)   "a display disposed within said first portable terminal for displaying a representation of said downloaded coupon information from said first portable terminal."

Mankoff, at col. 1, lines 44-54 and col. 5, lines 6-19, discloses a coupon image is displayed at the client's computer and not at the portable terminal or PDA. In contrast, Rissanen discloses the coupon information is displayed at the portable terminal, as shown in Fig. 2. Mankoff fails to disclose displaying downloaded coupon information at portable terminal.

The Examiner acknowledges that Mankoff fails to disclose or suggest "wirelessly pushing coupon information," and "a coupon matching that compares the stored coupon of promotions". Granger and Mazzamuto fail to supply the missing limitations in Mankoff for the reasons indicated in connection with the consideration of claim 1.

Claim 3 describes limitations not disclosed, suggested or taught in Mankoff, Mazzamuto and Granger, alone or in combination for the reasons indicated above and in connection with the consideration of claim 1. Withdrawal of the rejection and allowance of claim 3 are requested.

D.   Claims 4 & 42:

Claims 4 and 42 are the system embodiments of claims 1 and 41 and are patentable over Mankoff, Mazzamuto and Granger, for the same reasons indicated in connection with the consideration of claims 1 and 41.

E.   Claim 8:

Claim 8 depends from claim 1 and is patentable on the same basis as claim 1.

F.   Claims 11, 17, 29 & 38:

Claims 11, 17, 29 and 38 are patentable on the same basis as the claims from which they depend.

G.   Claims 8, 13, 26 and 35:

Claims 8, 13, 26 and 35 are patentable on the same basis as the claims from which they depend.

H.   Claims 19-20:

Claims 19 and 20 are patentable on the same basis as the claims from which they depend.

I.   Claims 31 & 37:

Claims 31 and 37 are patentable on the same basis as the claims from which they depend.

Withdrawal of the rejection and allowance of claims 1-4, 8, 11, 13, 17, 19-20, 26, 29, 31, 35, 27-38 and 41-42 are requested for the reasons discussed above.

Regarding Paragraph 4:

Claims 6, 10, 15, 21, 24, 28, 33 and 39 include limitations not disclosed in Mankoff, of record, in view of Granger, of record and Mankoff, of record, and in further view of Souissi, of record, as follows:

Claims 6, 10, 15, 21, 24, 28, 33 and 39 are patentable on the same basis as the claims from which they depend.

Withdrawal of the rejection and allowance of claims 6, 10, 15, 21, 24, 28, 33 and 39 are requested.

Regarding Paragraph 5:

Claim 42 includes limitations not disclosed in Mankoff in view of Granger and Mazzamuto and in further view of USP 6,311,171 to P. W. Dent, issued October 30, 2001, filed July 11, 1997, as follows:

(i)   "wherein said another terminal validates the transferred coupon information if the coupon information corresponds to any of the goods and/or services involved in the transaction, and if the coupon information is validated, calculating the discount provided by the coupon information to the purchase of goods and/or services;"

Mankoff, Granger and Mazzamuto and Dent all fail to disclose validating and redeeming a coupon at a point-of-sale terminal. Mankoff validates and redeems coupon information at different terminals. Granger, Mazzamuto and Dent all fail to validate coupon ID information for promotions. In any case, claim 42 includes limitations of claim 1 and 41 is patentable on the same basis thereof. Withdrawal of the rejection and allowance of claim 42 are requested.

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Patentability Support For Claim 61:

Claim 61 describes transferring coupon information to both the another terminal (redemption terminal) and to a second portable terminal via the Internet via wireless link for wider distribution of the coupon information as described in the specification at page 7, lines 19-25 and page 14, line 21 continuing to page 15, line 6. The cited art fails to disclose transferring coupon information to both the redemption terminal and another portable terminal via the Internet. Entry and allowance of claim 61 are requested.

CONCLUSION:

Applicant submits the objections to claims 2, 4, 41, 42, 59 and 60 have been overcome and the rejected claims are in condition for allowance. The rejections of claims 1, 3, 6, 8, 10, 11, 13, 15, 17, 19-21, 24, 26, 28, 29, 31, 33, 35, 37-39 and 50 have been rebutted and are believed patentably distinguished from the cited art, without the introduction of new matter. Patentability support has been provided for New Claim 61. Entry of the amendment, allowance of the pending claims and passage to issue of the case are requested.

AUTHORIZATION:

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 13-4503, Order No. 4208-4198. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4503, Order No. 4208-4198. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

Respectfully submitted,
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